

REMARKS

In the Office Action, the Examiner indicated that claims 1 through 16 are pending in the application and the Examiner rejected all claims.

A Supplemental Reply under 37 CFR §1.116 was filed concurrently with the Appeal Brief on July 18, 2005 in the present application. Since no indication was made in the present Office Action as to whether or not these amendments were entered, applicant is presenting the same amendments herein. The term "alternative bookmark directive" has been changed to "alternate bookmark directive" and the term "alternative URL" has been changed to "alternate URL". This is to correct a typographical error and to maintain consistency, since both terms are used interchangeably throughout the application.

Claim Rejections, 35 U.S.C. §102 and 35 U.S.C. §103

In item 3 on page 2 of the Office Action, the Examiner rejected claims 1, 2, 5-6, 9-10, and 13-14 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,486,891 to Rice ("Rice"). On page 5 of the Office Action, the Examiner rejected claims 3, 7, 11 and 15 under 35 U.S.C. §103(a) as being unpatentable over Rice in view of U.S. Patent No. 6,041,360 to Himmel et al.. Also on page 5, the Examiner rejected claims 4, 8, 12 and 16 under 35 U.S.C. §103(a) as being unpatentable over Rice in view of U.S. Patent No. 6,832,350 to Bates et al. (Applicant notes that in the Office Action, the Examiner referred to U.S. Patent No. 6,832,350 as being to Himmel et al. For purposes of this Reply, applicant is assuming that the Examiner was instead

referring to Bates et al., since the column and line numbers cited by the Examiner correspond to Bates et al.)

The Present Invention

The present invention provides a method for automatically bookmarking a URL specified by a web author when a user of a web browser attempts to bookmark a different page or when a process updates bookmarks based on either the HTTP 301 return code or the HTML meta refresh markup. In accordance with the present invention, a web page author places an "alternate bookmark directive" as either an HTML meta tag (claim 13) or an XML meta tag (e.g., claims 1, 5 and 9) in the page associated with a particular URL. When this "alternate bookmark directive" HTML or XML meta tag is received by the web browser or by a process updating bookmarks, and the user of the browser attempts to bookmark the URL being viewed or the process is verifying a bookmark, then either the browser is instead directed to bookmark the specifically predetermined alternate URL from the tag or the process modifies the bookmark being verified using the specifically predetermined alternate URL from the meta tag.

U.S. Patent No. 6,486,891 to Rice

U.S. Patent No. 6,486,891 to Rice ("Rice") teaches a method of facilitating the automated bookmarking of a web page associated with an online advertisement. Of relevance to the present Office Action is the discussion in Rice in column 6, lines 39-52. More specifically, Rice teaches

the transmission to the client of an automated bookmarking applet, such as a JAVA applet, when a user indicates a desire to bookmark a web page associated with an advertisement.

U.S. Patent No. 6,041,360 to Himmel et al.

U.S. Patent No. 6,041,360 to Himmel et al. ("Himmel") teaches access to the Internet using dynamic bookmarks. The Examiner relies upon Himmel for an asserted teaching of the dynamic updating of bookmarks using encoding in XML as a web page representation.

U.S. Patent No. 6,832,350 to Bates et al.

U.S. Patent No. 6,832,350 to Bates et al. ("Bates") is assigned to International Business Machines Corporation, as is the present invention. By virtue of its issuance on December 14, 2004, after the filing date of the present application, Bates qualifies as prior art only under 35 U.S.C. §102(e), and therefore cannot preclude patentability of the present invention under 35 U.S.C. §103(c).

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

As noted above, the present claimed invention includes the insertion of a predetermined alternative bookmark directive as an XML meta tag (claims 1, 5 and 9) or as an HTML meta tag (claim 13) in an encoded web page representation associated with a target URL that is being bookmarked. This predetermined alternative bookmark directive causes the web browser to bookmark the alternative URL instead of the target URL when a user of the web browser attempts to bookmark the target URL. It is specific, i.e., the web designer plans it ahead of time. This occurs regardless of whether or not the target URL is available. As set forth above, Rice contains no such teaching. Rice teaches the use of an automated bookmarking applet such as a JAVA applet, and thus adds to the complexity of the bookmarking operation. Since claims 1, 5, 9, and 13 have been amended to specifically recite the insertion of a predetermined alternate bookmark directive as an XML or HTML meta tag, and since Rice contains no such teaching, the claimed invention patentably defines over Rice. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 2, 5-6, 9-10, and 13-14 based on Rice.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

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The Examiner relies upon U.S. Patent No. 6,041,360 to Himmel for an alleged teaching of the use of encoding in XML as a web page representation in connection with dynamic updating of

bookmarks. Applicant does not deny that Himmel teaches that XML may be used to represent a web page. However, nothing in Himmel teaches or suggests the encoding of a predetermined alternate bookmark directive in an XML or HTML meta tag. Himmel simply discloses the updating of a traditional bookmark because the browser sees itself being redirected by the response headers when fetching a page, or it sees standard data markup in the page that is used in naming or classifying the bookmark. Without any teaching or suggestion of the encoding of a predetermined alternate bookmark directive in an XML or HTML meta tag as is claimed in each of claims 3, 7, 11, and 15 of the present invention, the addition of Himmel provides no basis for rejection of the claims. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 3, 7, 11 and 15 under 35 U.S.C. §103.

Regarding the rejection of claims 4, 8, 12 and 16, the rejection of each of these claims is based on the Bates et al. patent. As set forth above, Bates is assigned to International Business Machines Corporation, as is the present invention. Accordingly, Bates is not prior art for the purposes of a rejection under 35 U.S.C. §103, pursuant to 35 U.S.C. §103(c). Thus, it is submitted that the rejection of the claims under 35 U.S.C. §103, which specifically cite the Bates patent as prior art, are improper. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of claims 3, 7, 11 and 15 under 35 U.S.C. §103. Applicant notes that claim 4 has been rewritten in independent form and thus now stands alone as an independent claim.

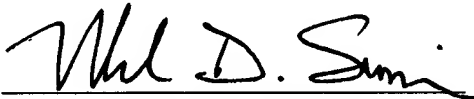
Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

A Petition extending the period for response, along with a Form PTO 2038 authorizing payment of the fee to a credit card, is enclosed. The Commissioner is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted

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Date


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